

### REMARKS

Claims 1-8, 10-13 and 16-34 are pending. Claims 1 and 16-19 are amended. Claim 1 incorporated material from claims 14 and 15. Claims 16-19 reflect a change in dependency necessitated by the amendments to claim 1. Claims 14 and 15 are canceled as redundant.

#### Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-8 and 10-34 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The use of the transition phrase “comprising” and the removal of the optional components from the express language should resolve any alleged lack of clarity.

#### Rejections Under 37 CFR § 1.75(c)

Claims 32-34 are alleged be improper for failing to further limit claim 1. This rejection is believed to be moot in view of the amendment of claim 1.

#### Alleged Obviousness-Type Double Patenting

Claims 1-8, 10-22, 24, 25, 27-31, and 34 were rejected on the ground of alleged nonstatutory obvious-type double patenting over claims 1-29 of the U.S. Patent No. 5,994,493 (“the Krebs patent”). To establish a *prima facie* case of obviousness, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Moreover, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The reason to make the claimed combination, and a reasonable expectation of success, must be found elsewhere than in Applicants disclosure, such as in the prior art, the nature of the problem to be solved, or in the knowledge/understanding of the person of ordinary skill in the art. MPEP § 2143; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants submit that the instant rejection does not meet these requirements.

The Krebs patent teaches a composition having polyurethane prepolymer and a number of optional ingredients. The polyurethane prepolymer in the Krebs patent is made from reactants comprising (1) an isocyanate, (2) a polyester polyol or polyether polyol and

(3) an aromatic polyol to form the reaction product. *See*, claims 1-29 of the Krebs patent. In contrast, the instant claims recite (i) a reaction product comprising (1) a particular isocyanate (at least 95% 2,4-diphenylmethane diisocyanate) and (2) polyether-polyol and/or polyalkylene diol components and (ii) a migratory polyisocyanate having a vapor pressure of less than  $10^{-6}$  hPa at 20 °C. Even if the Krebs patent teaches use a reaction product comprising (1) a particular isocyanate (at least 95% 2,4-diphenylmethane diisocyanate) and (2) polyether-polyol and/or polyalkylene diol components (a point Applicants do not concede), the claims of the Krebs patent do not teach or suggest use of the migratory polyisocyanate component .

In addition, in regard to the rejection of claims 14 and 15 which are now incorporated into claim 1, the Office asserts that the lower molecular weight polyisocyanates in the adhesive of the Krebs patent can be the adhesion-intensifying additive of the instant claims. Office Action at page 5. The monomeric diisocyanates (low molecular weight polyisocyanates) taught by the Krebs patent, however, would not have vapor pressures less than  $10^{-6}$  hPa at 20 °C as required by the instant adhesion-intensifying additive. For example, it is Applicants understanding that the vapor pressure of MDI at 20 °C is  $7.23 \times 10^{-6}$  hPa and the vapor pressure of NDI (naphthylene diisocyanate) at 20 °C is  $10^{-5}$  hPa. As such, the disclosure in the Krebs patent does not satisfy the adhesion-intensifying additive element of the instant claims.

Thus, the cited art does not teach or suggest all elements of the instant claims and is not obvious in view of the cited art. Withdrawal of the rejection is respectfully requested.

#### **Rejections Under 35 U.S.C. § 102(b)**

Claims 1-8, 10-22, 24-25, 27-31, and 34 were rejected as allegedly anticipated under 35 U.S.C. § 102(b) as allegedly anticipated by the Krebs patent. In addition the lack of teaching of the use of the migratory polyisocyanate component in the claims of the Krebs patent, the Krebs patent does not otherwise teach or suggest this element. For reasons discussed above, the instant claims are not anticipated by the Krebs patent.

**DOCKET NO.:** HENK-0066/ H5395  
**Application No.:** 10/822,625  
**Office Action Dated:** February 25, 2008

**PATENT**  
**REPLY FILED UNDER EXPEDITED**  
**PROCEDURE PURSUANT TO**  
**37 CFR § 1.116**

**Rejections Under 35 U.S.C. § 103(a)**

Claims 1-8, 10-34 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over the Krebs patent. As discussed above, to establish a *prima facie* case of obviousness, the cited art must teach or suggest all the claim limitations. The Krebs patent, however, does not teach or suggest the migratory polyisocyanate component of amended claim 1. For at least this reason, the Krebs patent does not render amended claim 1 obvious. Withdrawal of the rejection is respectfully requested.

Applicants believe that the foregoing constitutes a complete and full response to the Office Action of record. Accordingly, an early and favorable reconsideration of the rejections and an allowance of all of pending claims is earnestly solicited.

Respectfully submitted,

Date: June 19, 2008

/John A. Harrelson, Jr./  
\_\_\_\_\_  
John A. Harrelson, Jr., Ph.D.  
Registration No. 42,637

Woodcock Washburn LLP  
Cira Centre  
2929 Arch Street, 12th Floor  
Philadelphia, PA 19104-2891  
Telephone: (215) 568-3100  
Facsimile: (215) 568-3439